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OFFICE OF PETITIONS

In re Patent No. 8,166,384  
Issued: April 24, 2012  
Application No. 09/594,054  
Filed: June 14, 2000  
Attorney Docket No. 07844-0427001 /  
P391

: DECISION ON REQUEST  
: FOR RECONSIDERATION  
: OF PATENT TERM ADJUSTMENT :

This is a decision on the petition filed June 25, 2012, under 37 C.F.R. § 1.705 requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted to 3875 days.

The application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED**.

Patentee's agree that properly excluded from a calculation of "B Delay" is "time consumed by appellate review by the Board of Patent Appeals and Interferences." See 35 U.S.C. § 154(b)(1)(B). But argues that, as applied by the Office in the calculation of PTA for the instant patent, 37 C.F.R. § 1.703(b)(4) appears to exclude from "B Delay" time periods not encompassed by actual appellate review and is therefore inconsistent with the controlling statute. In particular, the Office's regulation excludes from "B Delay" time starting from when a Notice of Appeal is filed. This reduction of "B Delay" is a clear deviation from the requirements of 35 U.S.C. § 154(b)(1)(B), as it begins an exclusion before any potential appellate review ever takes place. "Appellate review," if it ever occurs at all after a Notice of Appeal is filed, cannot occur until jurisdiction passes to the Board of Patent Appeals and Interferences.

At the time the patent was granted, an appeal to the Board of Patent Appeals and Interferences commenced with the filing of a notice of appeal and ended with either 1) a Board decision, 2) the examiner reopening prosecution and issuing another Office action, or 3) the applicant filing a request to withdraw the appeal and reopen prosecution (e.g. the filing of a request for continued examination).

Under the rules in effect at the time of the calculation in the instant matter, excluding the period consumed by appellate review, whether successful or not, the Office properly excluded from the calculation of B delay, the period after the filing of the Notices of Appeal filed on July 7, 2004, and December 22, 2005. See 35 U.S.C. 134(a) and 35 U.S.C. 154(b)(1)(B)(ii). Thus there is no patent term adjustment for the periods

between the filing of the Notices of Appeal and the mailing of the subsequent Office Actions.

In view thereof, the request for reconsideration of patent term adjustment is **DISMISSED**.

Patentee is advised however, that the final rule, *Revision of Patent Term Adjustment Provisions Relating to Appellate Review* (77 FR 49354) issued on August 16, 2012. Based on patentee having made this timely request for patent term adjustment based on proposed changes to the Office's former interpretation of 35 U.S.C. 154(b)(1)(B)(ii) and (C)(iii), patentee is given a two-month period from the date of this decision limited to reconsideration of the Office's former interpretation of the appellate review language of 35 U.S.C. 154(b)(1)(B)(ii) and (C)(iii), in light of the final rule, *Revision of Patent Term Adjustment Provisions Relating to Appellate Review* (77 FR 49354) issued on August 16, 2012.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3212.



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